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09/691,175	10/19/2000	Daniel I. Flitcroft	032668-027	7048

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,175

Applicant(s)

FLITCROFT ET AL.

Examiner

Clement B Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/6/01, 10/02/02, 11/20/02, 1/6/04, 4/12/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 30-61 been renumbered claims 28-59.

2. Contrary to Applicant's statements with regards to IDS, submitted, during examination the examiner only received eight IDS with dates of 4/06/01, 10/02/02, 11/20/02 , 1/6/04, 4/12/04, 6/23/04, 8/12/04, 1/11/05.

3. Claims 1-30 has been cancelled and claims 30-61 remained pending.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

5. Claims 28-59, are rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the claims are directed towards an abstract idea. Claims 28-59 represent an abstract idea that does not provide a practical application in the technological arts. There is no post-computer process activity found, the claimed invention performs mathematical calculations with no post solution activity. Therefore applicant is reminded to embed a computer or processor or module into the body of the claims 28-59 in order to overcome this 101 rejection, appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 28-30, 37-50, 53, and 56-59, are rejected under 35 U.S.C. 102(e) as being anticipated by Joao et al (Hereinafter Joao U.S. Patent No. 5, 903, 830).

As per claim 28, Joao discloses a method for implementing a limited-use credit card system, the method composing:
allocating a limited-use credit card number (see column 16 lines 4-35)
associating the limited-use credit card number with a customer account number and a set of conditions (i.e. card is lost, stolen, cancelled and/or de-activated, or credit, charge or debit limit is reached and/or exceeded, currency value depleted, unauthorized transaction limit reached or exceeded limitations and/or restrictions violated, etc.), (note abstract and see column 17 lines 37-67 and column 18 lines 1-54 and column 7 lines 45-64 and column 5 lines 20-67) issuing the limited-use credit card number (see column 4 lines 19-31) detecting a transaction using the limited-use credit card number ("i. e, point of sale") and processing the transaction in accordance with the set of conditions associated with limited-use credit card number.(Note abstract and see 5 lines 45-67 and column 7 lines 45-64 and see column 16 lines 4-35).

As per claim 29, Joao discloses further comprising:
allocating additional limited-use credit card numbers upon a customer request and/or an event trigger ("i. e, exceed account limit or depleted funds"). (Note abstract and see column 16 lines 4-35 and abstract and see column 7 lines 45-64 and column 5 lines 20-67).

As per claim 30, Joao discloses wherein the event trigger ("i. e, exceed account limit or depleted funds") is the use of more than a preset amount of limited-use credit card numbers. (see column 5 lines 20-67)

As per claim 37, Joao discloses further comprising: notifying a user about parameters of the limited-use credit card system. (see column1 lines 5-31).

As per claim 38, Joao discloses wherein the user is notified e-mail. (see column 10 lines 56).

As per claim 39, Joao discloses wherein the parameters of the limited use credit card system comprise records of limited-use and other card transactions. (see column 16 lines 4-34).

As per claim 40, Joao discloses wherein the parameters of the limited-use credit card system comprise use of the limited use credit card number in a credit card transaction. (see column 5 lines 20-67).

As per claim 41, Joao discloses wherein the parameters of the limited-use credit card system comprise a number of the limited-use credit card number available to the user. (see column 16 lines 4-34).

As per claim 42, Joao discloses wherein the set of conditions are defined by a user of the limited-use credit card. (note abstract and see column 46 lines 6-14).

As per claim 43, Joao discloses wherein the set of conditions limits the use of the limited-use credit card number to a pro-defined user limit. (see column 16 lines 4-34).

As per claim 44, Joao discloses wherein the set of conditions limits the use of the limited-use credit card number to a particular merchant,(see column 5 lines 20-67)

As per claim 45, Joao discloses wherein the particular merchant is selected from a predetermined list of merchants and/or category of merchants("i. e, merchants") . (see column 5 lines 20-67).

As per claim 46, Joao discloses wherein the particular merchant ("i. e, merchant") is prearranged by the user. (see column 16 lines 4-34).

As per claim 47, Joao discloses wherein the set of conditions limits the use of the limited-use credit card number to a single transaction for a maximum transaction value for a single purpose (see column 7 lines 45-64 and column 16 lines 13-34).

As per claim 48, Joao discloses wherein the set of conditions limits the use of the limited-use credit card number to a set number of transactions for a maximum transaction value within a set time. (see column 7 lines 45-64 and column 16 lines 13-34).

As per claim 49, Joao discloses wherein the set of conditions limits the use of the limited-use credit card number to a single purpose. (see column 7 lines 45-64).

As per claim 50, Joao discloses wherein the set of conditions comprise at least one of the group consisting of transaction value conditions, time of transaction conditions, number of transactions conditions, frequency of transactions conditions, purpose of transaction conditions, merchant type conditions, and geographical conditions. (see column 7 lines 45-64 and column 16 lines 13-34).

As per claim 53, Joao discloses wherein dispensing a credit card comprises: printing out an indication of the limited-use credit card number for delivery to the user. (see column 16 lines 32-35).

As per claim 56, Joao discloses further comprising: dispensing the limited-use credit card number to user via a telecommunications system ("i. e, email"). (see column 3 lines 4-18).

As per claim 57, Joao discloses wherein the telecommunications system comprises a pager. (see column 14 lines 66-67 and column 15 lines 1-18).

As per claim 58, Joao discloses wherein the telecommunications system comprises a mobile phone. (see column 14 lines 66-67 and column 15 lines 1-18).

As per claim 57, Joao discloses further comprising: initiating the transaction using the limited-use credit card number via a telecommunications system. (Note abstract and see 5 lines 45-67 and column 7 lines 45-64 and see column 16 lines 4-35).

As per claim 58, Joao discloses wherein the telecommunications system comprises a pager. (see column 14 lines 66-67 and column 15 lines 1-18).

As per claim 59, Joao discloses wherein the telecommunications system comprises a mobile phone. (see column 14 lines 66-67 and column 15 lines 1-18).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 31-36 and 51-52, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al (Hereinafter Joao U.S. Patent No. 5, 903, 830).

As per claim 31, Joao discloses wherein processing the transaction comprises: authorizing or denying the transaction by comparing the transaction to the set of conditions associated with the limited-use credit card number (see column 5 lines 39-67) determining whether a limited use event has occurred (see column 5 lines 39-67) and deactivating the limited-use credit card number based on the limited-use event and/or the set of conditions associated with limited-use credit card number. (see column 5 lines 39-67).

As per claim 32, Joao discloses further comprising: associated said other limited-use credit card number with the customer account number (note abstract and see column 7 lines 45-64 and column 5 lines 20-67). assigning another limited-use credit card number in response to deactivating the limited-use credit card number.

However Joao discloses means for receiving one of a limitation and a restriction on an account usage, wherein said one of a limitation and a restriction on an account usage are received in real-time from an individual account holder means for storing said one of a limitation and a restriction on an account Usage (see column 46 lines 6-13) and the central processing computer will then process the information and/or data pertinent to the transaction and to the particular card account and may request, if needed, that the point-of-sale operator enter the transaction amount. The central processing computer will process the information and/or data pertinent to the transaction in conjunction with the card account information in order to determine if the card has been lost, stolen and/or cancelled and/or de-activated. Further, the central processing computer may perform a test in order to determine if the maximum credit, charge or debit account limit has been exceeded and/or if the card has been depleted of its currency value. (see column 5 lines 39-51).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Joao would have been able to activate the account number in event the account number was deactivated because the account holder can request or place limitations or restriction on the accounts.

As per claim 33, Joao discloses further comprising: maintaining a queue (i. e, database") of available limited-use credit card numbers (see column 16 lines 4-13) and assigning the limited use credit card number from the queue. (see column 16 lines 4-13).

Joao fail to explicitly teach assigning.

However Joao discloses accounts the central processing computer also comprises a database(s) which contains account information and data pertaining to the cardholders and/or to the cardholder accounts. The database contains information about the cardholder, the cardholders account number, credit and/or account limits, previous purchases, number of unauthorized purchases made to the account and other information and/or data necessary to manage and/or process an account transaction as described herein.(see column 16 lines 4-13).

Therefore it would have been obvious to one of ordinary skill in the art the time the invention was made that the teachings of Joao having stored card holders accounts numbers in its database would have been able to assign an account number from its database.

As per claim 34, Joao fail to explicitly teach wherein issuing the limited-use credit card number comprises:
downloading the limited-use credit card number to a user.

However they are many ways of transmitting information to a user, for example via email or regular U.S mail, and the means of transmitting the account number to the user do not in any way prevent the system from performing its true function of performing a transactions using limited use credit card numbers.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Joao would have been able to transmit the credit card number to the user because they are many ways of transmitting information to a user, for example via email or regular U.S mail, and the means of transmitting the account number to the user do not in any way prevent the system from performing its true function of performing a transactions using limited use credit card numbers.

As per claim 35, Joao fail to explicitly teach wherein the limited-use credit card number is encrypted prior to downloading.

However encryption and downloading a transaction or information is old and well known in the art because it allows for secure retrieval of information via a network such as the internet.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include limited-use credit card number is encrypted prior to downloading because it allows for secure retrieval of information via a network such as the internet.

As per claim 36, Joao fail to explicitly teach wherein issuing the limited-use credit card number comprises:
mailing the limited-use credit card number to a user.

However they are many ways of transmitting or issuing information to a user, for example via email or regular, U.S mail, or downloading and the means of issuing the account number to the user do not in any way prevent the system from performing its true function of performing a transactions using limited use credit card numbers.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Joao would have been able to issue the credit card number to the user because they are many ways of transmitting information to a user, for example via email or regular, U.S mail or downloading, further the means of issuing the account number to the user do not in any way prevent the system from performing its true function of performing a transactions using limited use credit card numbers.

As per claim 51-52, Joao fail to explicitly teach further comprising:
dispensing a credit card containing the limited-use credit card number and .
wherein the automated teller machine dispenses the credit card.

However card dispensing and machine are old and well known in the art because they are used to dispense a cards with a values, further the means of acquiring the cards or where the cards were bought or sold would not have prevented the system from performing a financial transaction when the card is tender by the holder.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings Joao to include dispensing a credit card containing the limited-use credit card number and wherein the automated teller machine dispenses the credit card because they are used to dispense a cards with a values, further the means of acquiring the cards or where the cards were bought or sold would not have prevented the system from performing a financial transaction when the card is tender by the holder.

Conclusion

Response to Arguments

10. Applicant's arguments filed on 05/03/2004 have been fully considered but are they are moot in view of new grounds of rejections.

11. In response to the 35 USC 101 rejection arguments, for a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result, and
- 2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note In re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In Musgrave, 167USPQ 280 (CCPA 1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

Applicant's arguments-with-regards to not being required to embed a computer or processor or module in to the claims because the it has satisfied the 101 rejection "as to method of doing business" are not persuasive.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. Ex parte Bowman 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished)

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Any inquiry concerning this communication from the examiner should be directed to Clement Graham at (703) 305-1874. The examiner can normally be reached on Monday, Tuesday, and Wednesday from 5:30AM. to 6:00PM.

12. If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on (703) 305-0505.

The Official Fax Number for TC-3600 is: (703) 305-7687

Clement Graham

March 14, 2005


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600